

Attorney Docket No. 27866/32960

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Patrick W. Gray)	"EXPRESS MAIL" mailing label No. EM 099831960US
Serial No.: Rule 53(d) continuation)	
of Serial No. 08/663,618)	Date of Deposit: September 11, 1998
Filed: herewith)	I hereby certify that this paper and all
)	documents referred to therein as being
For: "Chitinase Materials and)	enclosed are being deposited with the
Methods")	United States Postal Service
)	"EXPRESS MAIL POST OFFICE TO
Group Art Unit: 1652)	ADDRESSEE" service under 37
)	C.F.R. §1.10 on the date indicated
Examiner: R. Prouty, Ph.D.)	above and is addressed to the
	Ć	Assistant Commissioner for Patents.
)	
)	Kichaul Jananes
	Ś	Richard Zimmermann
	,	

REQUEST FOR RECONSIDERATION WITH SECOND DECLARATION OF PATRICK GRAY UNDER 37 C.F.R. §1.131

Box CPA Assistant Commissioner for Patents Washington, DC 20231

Sir:

A Rule 53(d) continued prosecution application request is filed herewith. This paper is in response to the final Office Action mailed March 13, 1998 in U.S. Application Serial No. 08/663,618 filed June 14, 1996, in which claims 1-6 and 13-18 were rejected under §102(a) and claims 7-12 and 29 were rejected under §103(a). Reconsideration is respectfully requested in light of the following remarks. These papers are timely filed with a petition for a three month extension of time as filed herewith.

Currently pending claims 1-18 relate to polynucleotides encoding human chitinase enzyme, vectors and host cells comprising such polynucleotides, and methods for using such host cells to produce human chitinase, and are based on Applicant's isolation of DNA encoding human chitinase. Two exemplary embodiments are the DNA inserts contained in plasmids MO-218 and MO-13B (SEQ ID NOS:1 and 3).

The sole remaining rejection in the March 13, 1998 Action was that the claims are allegedly unpatentable under 35 U.S.C. §102(a) (for claims 1-6 and 13-18) or §103(a) (for claims 7-12) over Boot et al., J. Biol. Chem., 270:26252-26256 (1995) (hereafter "Boot"). Although Applicants had previously submitted a Declaration of Patrick Gray Under 37 C.F.R. §1.131 to remove the Boot reference as prior art, the Examiner objected to this declaration on grounds that "the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA country prior to the effective date of the Boot et al. reference." The Examiner stated in particular that she was unable to identify a reference to plasmid MO-218 on the notebook page attached as Exhibit 1 to the declaration because it was a poor photocopy of the original. In addition, during a telephonic interview with the undersigned on August 11, 1998, the Examiner expressed specific concerns that the evidence submitted should show not only possession of plasmid MO-218 but recognition that MO-218 encoded a chitinase. After the undersigned explained the contents of the notebook page and offered to file further supporting documentation, the Examiner expressed general satisfaction with the evidence but required a further declaration clarifying the evidence.

In response, Applicant submits herewith a Second Declaration of Patrick W. Gray Under 37 C.F.R. §1.131 (Exhibit A hereto) that further explains Exhibit 1 to Dr. Gray's previous declaration (now Exhibit 2 to Dr. Gray's Second Declaration) and that includes supporting documentation showing sequence data and sequence comparison results. Applicant respectfully submits that this Second Declaration shows that Applicant isolated the human chitinase gene and completed the invention before the November, 1995 publication date of the Boot article. The rejections under 35 U.S.C. §§102 and 103 thus may properly be withdrawn because Boot is removed as a reference against the claims of this application.

Conclusion

In light of the foregoing amendments and remarks, it is believed that claims 1-18 are now in condition for allowance, and early notice thereof is solicited.

Respectfully submitted,

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By:

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September 11, 1998